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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,053	11/21/2001	Matthias Riepenhoff	70366	1467

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EXAMINER

PHAM, HAI CHI

ART UNIT PAPER NUMBER

2861

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/990,053

Applicant(s)

RIEPENHOFF, MATTHIAS

Examiner

Hai C Pham

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Objections*

2. Claims **5** and **17** are objected to because of the following informalities:

#### Claim 5:

- Line 3, "said lens symmetrical lens" should read --said lens symmetrical lens--.

#### Claim 17:

- Line 3, "said lens symmetrical lens" should read --said lens symmetrical lens--.

Appropriate correction is required.

3. Claims **10** and **11** are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claims 10 and 11 claim a lens system according to claims 5 and 9, respectively, including a printing form to be illustrated. However, claims 5 and 9, which are dependent from the base claim1, are directed to a lens system for illustrating a printing form. In other words, claims 10 and 11 fail to recite any further limitations.

***Duplicate Claims Warning***

4. Applicant is advised that should claims **3** and **15** be found allowable, claims **4** and **16** will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims **3** and **4** are exact replicate of each other, as well as the pair of claims **15** and **16**.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-6, 10, 15-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "**asymmetrical**" in claims 3-6 and 15-18 is used by the claims to mean "aspherical," while an aspherical lens is not necessary an asymmetrical lens since an aspherical may be perfectly axially symmetrical. On the other hand, the terms "**symmetrical**" and "**asymmetrical**" in claims 3-6 and 15-18 is used by the claims to mean "spherical" and "aspherical," respectively, while the

specification never mentions such terms nor relates the similarity of the different terms being recited [only] in the claims.

Claim 10 is dependent from claim 5, and is therefore indefinite.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1, 7-8, 12-13, 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Iwasa et al. (U.S. 6,144,685).

Iwasa et al. discloses a surface emitting laser array beam scanner including a first scanning optical system (21) made of a spherical lens and a second scanning optical

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system (22) made of an aspherical lens for printing an image on the photosensitive drum (15) (Fig. 10A). With regard to claims 12-13, Iwasa et al. teaches the laser light array being focused onto desired spots forming a strip corresponding to the area element to be exposed (strip width and height corresponding to the dimension of the two-dimensional laser array) (see Fig. 9A), the strip being swept continuously such that the entire height of the printing area of the photosensitive drum (15) is exposed.

9. Claims 1-2, 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Akatsu (U.S. 5,914,800).

Akatsu discloses a multi-beam optical scanning system including a spherical lens (5), an aspherical lens (6), and a cylinder lens (7) for exposing the surface of the photoreceptor (8) along a strip formed by the successive scanning lines (Fig. 1) such that the entire height of the printing area of the photoreceptor is exposed.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3-4, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasa et al. in view of Ishihara et al. (JP 9-211280).

Iwasa et al. discloses all the basic limitations of the claimed invention except for the lenses being integrated as an optical element.

Ishihara et al. discloses an optical system having a spherical lens (8) and an aspherical lens (2) being cemented as an integral optical system. for the purpose of suppressing the spacing and eccentricity errors.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Iwasa et al. with the aforementioned teaching of Ishihara et al for the purpose of suppressing the spacing and eccentricity errors as suggested by Ishihara et al. (see Ishihara et al.'s problem solving).

12. Claims 5-6, 9-11, 17-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasa et al. in view of Nakamura et al. (U.S. 5,745,296).

Iwasa et al. discloses all the basic limitations of the claimed invention except for the focusing points coinciding with one another.

Nakamura et al. discloses a multi-beam recording device including a set of scanning lenses (21 and 22) arranged between the emitter unit (10) and the recording medium (P) such that the focal point of the first lens unit (21) coincides with the focal point of the second lens unit (22) (Fig. 1) for the purpose of correcting decentering errors. Nakamura et al. further teaches the first lens unit (21) being disposed in front of the emitter unit (10) such that the focal point of the first lens unit is at a greater distance than the first lens unit to the light-emitting area of the emitter unit (Fig. 1).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the device of Iwasa et al. with the aforementioned

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teaching of Nakamura et al for the purpose of correcting decentering errors as suggested by Nakamura et al.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin R. Fuller can be reached on (703) 308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**HAI PHAM  
PRIMARY EXAMINER**

March 10, 2003